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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,254	11/15/2001	Thomas E. Hansen	154.008US1	9048

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Mark A. Litman & Associates, P.A.
York Business Center
Suite 205
3209 West 76th St.
Edina, MN 55435

EXAMINER	
MAYES, MELVIN C	
ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/000,254	HANSEN ET AL
	Examiner	Art Unit
	Melvin Curtis Mayes	1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *11-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 November 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2, 3, 4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

(1)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10 and 18, drawn to a method and apparatus for enabling a linered label applicator to accept linerless label sheet and a source of linerless labels, classified in class 156, subclass 249.

II. Claims 11-13, drawn to a source of linerless label, classified in class 428, subclass 41.8.

II. Claims 14-17, drawn to a method for creating a label on a temporary reusable carrier, classified in class 156, subclass 257.

(2)

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process such as providing a roll of labels for peeling labels by hand from the roll for application to objects.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require

the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require printing before cutting the sheet material or cutting so that the labels have a micro-bridged cut of less than 10%. The subcombination has separate utility such as for making conventional linered labels instead of linerless labels adhered to a carrier.

Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make other product such as conventional linered labels on a carrier and the product as claimed can be made by printing and cutting after applying linerless label material to a carrier.

(3)

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

(4)

During a telephone conversation with Mark Litman on September 23, 2003, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10 and 18.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

(5)

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

(6)

Claim 18 is objected to because of the following informalities: the claim contains the phrase "so that a composite of:...labels" which is a phrase which does not have an ending. Appropriate correction is required.

Claim Rejections - 35 USC § 112

(7)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(8)

Claims 7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7, 9 and 10 claims that the roll is used to feed "**liner** on a thin liner" or "**liner** on a reusable, temporary liner." Does this mean that there is liner on a second liner? Does Applicant mean to claim "to feed **label** on a thin liner"? This is not clear.

Claim Rejections - 35 USC § 103

(9)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(10)

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/07883 in view of WO 00/30963, Koehlinger et al. 3,920,122 and Boreali 5,573,621.

WO 00/07883 discloses a method of applying linerless labels comprising: providing prerolled linerless labels by providing a stream of linerless labels off a manufacturing liner, partially severing individual labels on the continuous sheets, applying the continuous sheet with severed labels to a temporary, reusable support liner and rolling the label/support composite; associating the source of precut linerless labels on the roll of reusable support liner to a linered label applicator so that a composite of reusable, temporary liner sheet and cut linerless labels is fed to the linered applicator where linered label is normally directed; removing the cut linerless label from the liner sheet and applying to a substrate; and after removal of the label, winding the liner sheet into a roll. The roll is fed to an the applicator which operates by bending the linerless label on the liner to partially remove at least a part of an edge of the label from the liner, having

the lifted edge placed into contact with a surface to which the label is to be applied and attaching the label to the surface (pgs. 11-12). WO '883 does not specifically disclose that the partially severed linerless labels have a border defined by a micro-bridged cut along the border.

WO 00/30963 teaches that for dispensing flat forms such as labels from a web-like starting material, dispensing problems of freeing the labels from the remaining punch material (lattice stripping) are avoided by punching the outer contour of the label from the web-like starting material such that at least one point between the label and the rest of the material is not punched through. The contour of the label is not punched completely from the web-like material, but instead at least one point or just a few points of the contour are not punched, forming tiny bridges between the label and the remains of the web-like material, which bridges function to fix the labels at their position within the web-like material until dispensed. The number and dimensions of the bridges depend on the material properties of the web-like material (as described in US equivalent Schumann et al. 6,571,983, col. 1, line 4 – col. 3, line 38).

Koehlinger et al. teach that the number and dimensions of bridges that are used to support labels on web remnant are dependent upon the nature of the label web material, should provide enough support so that the labels do not fall from the web remnant prior to the time they reach the application stations and be limited in number as much as possible for appearance purposes. Koehlinger et al. teach using bridges of width of 0.015 inches to 0.045 inches (col. 5, line 52 – col. 6, line 68).

Boreali teaches that ties for connecting linerless labels to matrix preferably have a width of 0.0018-0.030 inches (col. 3, lines 64-66).

It would have been obvious to one of ordinary skill in the art to have modified the method of WO '883 for applying linerless labels by providing the continuous sheet of partially severed linerless labels on the temporary liner as labels connected to the continuous sheet by one or a few tiny bridges, as taught by WO '963, to avoid the problems with dispensing labels from a web-like starting material. By providing one or a few punched tiny bridges to connect the linerless labels to the remnant (matrix) of the continuous linerless label sheet, linerless labels having a border defined by a bridges cut along the border are provided on the temporary liner, as claimed.

Providing the bridges as micro-bridges would have been obvious to one of ordinary skill in the art, as WO '0963 teaches that the number and dimensions of the bridges depend on the material properties of the web-like material, and Koehlinger et al. teach that the number and dimensions of bridges that are used to support labels on web remnant are dependent upon the nature of the label web material and should provide enough support so that the labels do not fall from the web remnant prior to the time they reach the application stations and can be of widths of 0.015 inches to 0.045 inches, while Boreali teaches that ties (bridges) for connecting linerless labels to matrix preferably have a width of 0.0018-0.030 inches. By providing bridges of widths as suggested by Koehlinger et al. and Boreali, micro-bridges are provided as claimed which each comprise not more than 3% of the border of a label, as claimed in Claim 2. Providing the bridges to make up less than 10% of the total border of each label, as claimed in Claim 2, would have been obvious to one of ordinary skill in the art, as Koehlinger teach that the number of bridges should be limited in number as much as possible for appearance purposes.

By providing continuous sheet having micro-bridged labels on the temporary liner and removing the labels from the composite of continuous sheet/liner for application to a substrate, matrix is obviously left on the temporary liner when the labels are removed from the liner, as claimed in Claim 3.

(11)

Claims 5, 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Muschelewicz et al.

Muschelewicz et al. teach that a multilayered sheet useful as a release backing for pressure sensitive adhesive labels but substantially thinner yet as strong as silicone-coated paper materials and offers excellent release properties and durability comprises a polymeric layer of thickness ranging from 0.25 to 1.5 mils (0.006 to 0.38 mm) laminated to a paper layer comprising tissue paper or kraft paper for making a laminated structure having a thickness of 1.5 mils or less (col. 2, line 65 – col. 3, line 8, col. 3, lines 54-60, col. 4, lines 18-29, col. 8, lines 1-6).

It would have been obvious to one of ordinary skill in the art to have modified the method of the references as combined by comprising the temporary liner of a sheet of less than 0.032 mm (1.3 mils) in thickness and a polymer film of less than 0.025 mm (0.98 mils) thickness, as Muschelewicz et al. teach that a release backing for use with labels and which is substantially thinner yet as strong as silicone-coated paper materials and offers excellent release properties and durability comprises a polymeric layer of thickness ranging from 0.25 to 1.5 mils (0.006 to 0.38 mm) laminated to a paper layer comprising tissue paper or kraft paper to make a laminated structure having a thickness of 1.5 mils or less. By providing a polymeric layer of

thickness of 0.25 mils (0.006 mm) on a tissue paper or kraft paper to form a release backing of thickness of 1.5 mils (0.38 mils) or less, a temporary liner comprising sheet (tissue paper) of less than 0.32 mm (1.3 mils) thickness and polymer film of less than 0.025 mm (0.98 mils) thickness, as claimed, is obviously provided.

Double Patenting

(12)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(13)

Claims 1-4 and 7-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,294,038 in view of WO 00/07883, WO 00/30963, Koehlinger et al. 3,920,122 and Boreali 5,573,621.

Claims 1-3 of U.S. Patent No. 6,294,038 claims a method for enabling a linered label applicator to accept linerless label sheet comprising the steps as claimed except the claims do not claim the linerless labels have a border having a linear distance defined by a micro-bridged cut along the border.

WO 00/07883 teaches that in applying linerless labels using a linered label applicator, the roll of linerless labels on the temporary liner sheet can be provided by providing a stream of linerless labels off a manufacturing liner, partially severing individual labels on the continuous sheets, applying the continuous sheet with severed labels to a temporary, reusable support liner and rolling the label/support composite (pgs. 11-12). WO '883 does not specifically disclose that the partially severed linerless labels have a border defined by a micro-bridged cut along the border.

WO 00/30963 teaches that for dispensing flat forms such as labels from a web-like starting material, dispensing problems of freeing the labels from the remaining punch material (lattice stripping) are avoided by punching the outer contour of the label from the web-like starting material such that at least one point between the label and the rest of the material is not punched through. The contour of the label is not punched completely from the web-like material, but instead at least one point or just a few points of the contour are not punched, forming tiny bridges between the label and the remains of the web-like material, which bridges function to fix the labels at their position within the web-like material until dispensed. The number and dimensions of the bridges depend on the material properties of the web-like material (as described in US equivalent Schumann et al. 6,571,983, col. 1, line 4 – col. 3, line 38).

Koehlinger et al. teach that the number and dimensions of bridges that are used to support labels on web remnant are dependent upon the nature of the label web material, should provide enough support so that the labels do not fall from the web remnant prior to the time they reach the application stations and be limited in number as much as possible for appearance purposes.

Koehlinger et al. teach using bridges of width of 0.015 inches to 0.045 inches (col. 5, line 52 – col. 6, line 68).

Boreali teaches that ties for connecting linerless labels to matrix preferably have a width of 0.0018-0.030 inches (col. 3, lines 64-66).

It would have been obvious to one of ordinary skill in the art to have modified the method of U.S. Patent No. 6,294,038 for enabling a linered label applicator to accept linerless label sheet by providing the roll of linerless labels on the temporary liner sheet by providing a stream of linerless labels off a manufacturing liner, partially severing individual labels on the continuous sheets, applying the continuous sheet with severed labels to a temporary, reusable support liner and rolling the label/support composite, as taught by WO '883 for providing a roll of linerless labels on the temporary liner sheet for use in a linered label applicator. Providing partially severed linerless labels on the continuous sheet by providing the labels connected to the continuous sheet by one or a few tiny bridges would have been obvious to one of ordinary skill in the art, as taught by WO '963, to avoid the problems with dispensing labels from a web-like starting material. By providing one or a few punched tiny bridges to connect the linerless labels to the remnant (matrix) of the continuous linerless label sheet, linerless labels having a border defined by a bridges cut along the border are provided on the temporary liner, as claimed.

Providing the bridges as micro-bridges would have been obvious to one of ordinary skill in the art, as WO '0963 teaches that the number and dimensions of the bridges depend on the material properties of the web-like material, and Koehlinger et al. teach that the number and dimensions of bridges that are used to support labels on web remnant are dependent upon the nature of the label web material and should provide enough support so that the labels do not fall

from the web remnant prior to the time they reach the application stations and can be of widths of 0.015 inches to 0.045 inches, while Boreali teaches that ties (bridges) for connecting linerless labels to matrix preferably have a width of 0.0018-0.030 inches. By providing bridges of widths as suggested by Koehlinger et al. and Boreali, micro-bridges are provided as claimed which each comprise not more than 3% of the border of a label, as claimed in Claim 2. Providing the bridges to make up less than 10% of the total border of each label, as claimed in Claim 2, would have been obvious to one of ordinary skill in the art, as Koehlinger teach that the number of bridges should be limited in number as much as possible for appearance purposes.

By providing continuous sheet having micro-bridged labels on the temporary liner and removing the labels from the composite of continuous sheet/liner for application to a substrate, matrix is obviously left on the temporary liner when the labels are removed from the liner, as claimed in Claim 3.

(14)

Claims 5, 6 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the references as applied to Claim 2, and further in view of Muschelewicz et al.

Muschelewicz et al. teach that a multilayered sheet useful as a release backing for pressure sensitive adhesive labels but substantially thinner yet as strong as silicone-coated paper materials and offers excellent release properties and durability comprises a polymeric layer of thickness ranging from 0.25 to 1.5 mils (0.006 to 0.38 mm) laminated to a paper layer comprising tissue paper or kraft paper for making a laminated structure having a thickness of

1.5 mils or less (col. 2, line 65 – col. 3, line 8, col. 3, lines 54-60, col. 4, lines 18-29, col. 8, lines 1-6).

It would have been obvious to one of ordinary skill in the art to have modified the method of the references as combined by comprising the temporary liner of a sheet of less than 0.032 mm (1.3 mils) in thickness and a polymer film of less than 0.025 mm (0.98 mils) thickness, as Muschelewicz et al. teach that a release backing for use with labels and which is substantially thinner yet as strong as silicone-coated paper materials and offers excellent release properties and durability comprises a polymeric layer of thickness ranging from 0.25 to 1.5 mils (0.006 to 0.38 mm) laminated to a paper layer comprising tissue paper or kraft paper to make a laminated structure having a thickness of 1.5 mils or less. By providing a polymeric layer of thickness of 0.25 mils (0.006 mm) on a tissue paper or kraft paper to form a release backing of thickness of 1.5 mils (0.38 mils) or less, a temporary liner comprising sheet (tissue paper) of less than 0.32 mm (1.3 mils) thickness and polymer film of less than 0.025 mm (0.98 mils) thickness, as claimed, is obviously provided.

Conclusion

(15)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(16)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 703-308-1977. The examiner can normally be reached on Mon-Fri 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM